

Attorney Docket # 3415-11CIP

Serial No. 09/688,482
Amdt. dated February 3, 2004
Reply to Office Action dated October 3, 2003

REMARKS/ARGUMENTS

Before the present amendment, Claims 1-9 and 18-20 were pending, with Claim 1 being in independent form, and Claims 10-17 having been previously withdrawn. In the present amendment, Claims 2 and 3 have been amended to clarify the nature of the present invention and to correct minor typographical errors, and Claims 18-20 have been cancelled without prejudice. FIGS. 11, 11A, 11B, 11C, 11D, 11E, and 11F have been added, and textual material describing FIGS. 11, 11A, 11B, 11C, 11D, 11E, and 11F has been added to the specification. After the present amendment is entered, Claims 1-9 will be pending, with Claim 1 being in independent form. Reconsideration and withdrawal of the rejections are requested on the basis of the following remarks.

In ¶7 of the Office Action, the Examiner noted that, although the legend "Page -1- of 2" appears at the bottom of PTO Form 149 in the IDS dated December 28, 2000, there is no page 2 (Office Action, ¶7). The Examiner further required "appropriate correction". Applicant confirms that the legend "Page -1- of 2" is indeed incorrect - there is no page 2. Applicant further suggests that the appropriate correction of this typographical error be the annotation of this fact on the appropriate sheet of paper in the file history. If any further action is required, applicant respectfully requests that the further action be specifically described in the next Office Action, so that applicant may comply.

In ¶8, the Examiner objected to the drawings under 37 CFR §1.83(a); noting specific features that were missing from the drawings, and highly recommended that applicant ensure that all method steps claimed are shown in the drawings. In response, applicant has added FIGS. 11, 11A, 11B, 11C, 11D, 11E, and 11F, and also added textual material to the specification describing FIGS. 11, 11A, 11B, 11C, 11D, 11E, and 11F. Neither the FIGS. nor the textual material contain new matter, as they are both directly derived from Claims 1-9. It is believed that these amendments will obviate this objection. Withdrawal of the objection is respectfully requested.

In ¶11, the Examiner rejected dependent Claim 4 under §101 as being directed to non-statutory subject matter; specifically, the Examiner asserts that "the limitation of 'by the customer' specifically limits the claim to a particular human (i.e. a customer as opposed the an [sic]

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employee)." It is true one cannot claim a human being. But one can claim an action, or series of actions, or steps, taken by a human being, in a method claim. Perhaps the best response to this rejection is the fact that, if one searches the PTO database, one will find the phrase "by the customer" appears in the claims of at least 5,000 issued patents. Withdrawal of the rejection is requested.

In ¶12, the Examiner rejected Claims 18-20 under §101 as directed to non-statutory subject matter, because the "claims are neither directed to a 'process' nor a 'machine' but rather embraces or overlaps two different statutory classes of invention". Claims 18-20 have been cancelled without prejudice. Withdrawal of the rejection is respectfully requested.

In ¶14, the Examiner rejected dependent Claim 8 under 35 USC §112, first paragraph, as not described and/or enabled by the written description. However, the Examiner also noted that if the applicant expressly admits on the record that such procedures are well-known in the art, then this particular rejection will be withdrawn (Office Action, ¶15). The applicant expressly admits that such procedures are well-known in the art and respectfully requests the rejection be withdrawn.

In ¶17, the Examiner rejects dependent Claims 4, 8, 9, and 18-20 under §112, second paragraph, as being indefinite for various reasons explored below.

In ¶17(a), it appears the Examiner finds Claim 4 indefinite because of the erroneous §101 rejection in ¶11. Withdrawal of the rejection is respectfully requested.

In ¶17(b), the Examiner alleged that "it is unknown what objects are needed to perform the claimed step ..." recited in Claim 8. As stated in reference to ¶14 above, applicant expressly admits that such objects and procedures are well-known in the art. Information which is well known in the art need not be described in detail in the specification. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1379-80, 231 USPQ at 94. Thus, the rejection is obviated. Withdrawal of the rejection is respectfully requested.

In ¶17(c), the Examiner alleged that it was unclear whether the "cover" recited in line 5 of Claim 9 is the same as the "cover" recited in line 3 of Claim 1. In fact, the relationship between the two is clear. Claim 9 recites "placing the plurality of items in a plurality of totes, wherein each of said plural totes comprises a cover . . . ", thus indicating that each of the plural totes has a cover.

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Claim 1 recites that the tote in Claim 3 has a cover. Withdrawal of the rejection is respectfully requested.

In ¶17(d), the Examiner rejected Claims 18-20, which have been cancelled without prejudice, and thus, the rejection is moot.

In ¶19, the Examiner rejected independent Claim 1, as well as Claims 2-9 and 18-20 depending therefrom, under 35 USC §102(b) as anticipated by *Liposky*; alternately, in ¶21, the Examiner rejected the same claims under 35 USC §103(a) as unpatentable over *Sone* in view of *Liposky*. Claims 18-20 have been cancelled.

Sone describes an "automatic replenishment system" in which both a refrigerated and unrefrigerated compartment are installed into the side of a house so that the compartments have both an inside door for the resident/user and an outside door for delivery (see Abstract, FIGS. 1 and 2, *Sone*). The compartments are "intelligent", meaning that sensors monitor the inventory of items within the compartments and the system automatically contacts vendors to replenish the inventory when necessary. *Liposky* describes a bag chained to the door of a retail store, where the chained bag is used to store bakery goods. The specific use for the chained bag in *Liposky* is for the delivery of bakery products to closed and locked stores early in the morning.

By contrast, independent Claim 1 of the present invention recites "placing the item in a tote, wherein said tote comprises a cover, a main structure, and a pair of eyelets on an exterior of the tote, including a first of the pair of eyelets on exterior of the cover and a second of the pair of eyelets on the exterior of the main structure substantially in proximity to the first eyelet". None of *Sone*, *Liposky*, or their combination teach or suggestion such a limitation. Therefore, Claim 1 is patentable over the combination of *Sone* and *Liposky*. At least through their dependence on independent Claim 1, which is believed to be patentable over the combination of *Sone* and *Liposky*, dependency Claims 2-9 are also believed to be patentable over the combination of *Sone* and *Liposky*. Withdrawal of the rejections are respectfully requested.

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Applicant believes all pending claims are in condition for allowance, which is respectfully requested.

Respectfully submitted,

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